

REMARKS

Initially, the Applicants note that claims 22-24 have been cancelled. Therefore, the rejections of those claims are deemed moot.

Independent claim 21 has been rejected under 35 U.S.C. § 102(b) as being anticipated by Geisser (U.S. Patent No. 5,454,815). The Applicants respectfully disagree with this rejection. Claim 21 recites, *inter alia*, a rasp wherein “when said rasp is put into an autoclave at at least 137°C, said rasp deteriorates itself and cannot be used anymore.” Although the Examiner previously admitted that Geisser fails to disclose this feature, the Examiner now asserts that Geisser teaches plastic that is inherently capable of deteriorating when put into an autoclave set to at least 137 degrees Celsius. (*Compare* paragraph 9 of Office Action mailed 10/16/08 with paragraph 3 of Office Action mailed 2/4/08, which stated: “Geisser fails to disclose the device being manufactured from a plastic capable of deteriorating when placed in an autoclave at a temperature of at least 137 degrees Celsius.”) Applicants maintain that Geisser does not disclose a rasp that deteriorates itself and cannot be used anymore when the rasp is put into an autoclave at at least 137 degrees Celsius, as is required by the claim.

Furthermore, claim 21 recites a rasp comprising protrusions “made of a plastic material which are to come into contact with the part of the bone and to rasp it from the bone, said plastic material being hard enough for this removal...” Applicants assert that Geisser does not disclose a rasp made of a plastic material being *hard enough* to rasp or remove bone. The enclosed declaration of Jean François Biegun, one of the Applicants, provided under 37 CFR § 1.132, establishes the following:

1. That he has manufactured two bone rasps -- one according to the concepts of the present application with a pre-treatment of exposition to Beta or Gamma rays, and another according to the prior art without a pre-treatment of exposition to Beta or Gamma rays.
2. That the bone rasp prepared according to the concepts of the claims of the present application has a Shore D Hardness value of 85.3.
3. That the prior art bone rasp has a Shore D Hardness value of 83.3.

4. That the Shore D Hardness value of the cortical bone ranges between 85 and 95.
5. Since the prior art bone rasp (such as a rasp disclosed in Geisser) is not as hard as the bone to be rasped, it is therefore not able to rasp bone.

Thus, Geisser does not disclose a rasp comprising protrusions made of a plastic material that is hard enough to rasp or remove bone, as is required by claim 21. Reconsideration is earnestly solicited. Upon such reconsideration, it is believed that the Examiner will find claim 21 allowable. As a result, the claims which depend therefrom are likewise allowable. However, at least some of these dependent claims are allowable of their own merit. For example, claims 17 and 19 were rejected under 35 U.S.C. § 103 based on the combination of Geisser and Judd U.S. Patent No. 1,396,934. However, regarding Judd, the Applicants respectfully assert that one skilled in the art of bone rasps would not consider its teachings. Specifically, the toilet seat of Judd is designed to bear compressive forces. But there is no teaching, express or otherwise, in Judd that adding metal inserts will increase the capability of the seat to support higher shearing forces that come with rasping bone. Therefore, one of skill in the art of bone rasps would have no reason to look at the teachings of Judd and modify the rasp of Geisser.

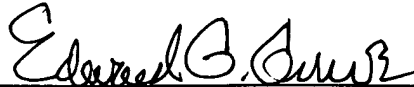
Independent claim 20 was rejected as obvious under 35 U.S.C. § 103 based on the combination of Geisser and Morgan U.S. Patent No. 5,910,106. Claim 20 recites exposing a rasp having protrusions made of a plastic material to Beta or Gamma rays, so that after this exposition, the plastic material is hard enough to remove the part of the bone from the bone when the rasp is used. Again, Geisser does not disclose a rasp having protrusions made of a plastic material that is hard enough to rasp bone, so the basic reference is deficient in that regard.

With respect to the teachings in the Morgan reference, the Applicants respectfully assert that since the stated object of Geisser is to "provide a rasp that avoids the cleaning and sterilizing steps and yet is always sterile and ready for operation," (beginning at col. 1, line 42), one of skill in the art of bone rasps would have no reason to consider other references aimed at sterilizing a device. Since Geisser specifically teaches that its rasp "has therefore neither to be cleaned nor

sterilized," (beginning at col. 1, line 62), one would not turn to the teachings in Morgan which relate to sterilizing a tool.

In view of the foregoing, the Applicants respectfully request the issuance of a Notice of Allowance for claims 12, 13, and 15-21. If any issues remain, a telephone call to the undersigned would be appreciated.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Edward G. Greive", written over a horizontal line.

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